

### REMARKS

In response to the Office Action dated April 10, 2003, Applicant respectfully requests the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following remarks. Claims 12 and 13 have been cancelled, without prejudice. Therefore, Claims 1-11 and 14-36 remain pending for examination.

#### Rejections Under 35 U.S.C. § 112

The Examiner has rejected Claims 3, 12 and 13 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 has been amended to address the Examiner's concerns. For example, the term "computerized" has been added to the preamble to make clear that the storage device referred to in the claim is a computer readable medium. In addition, "the storage device defines" has been amended to read "the storage device stores" to clarify the operation of the storage device. Additionally, the testing module element has been amended to indicate that the questions provided by the testing module refer to the same questions as those provided by the storage device. Still further, the lack of antecedent basis for "the computer" has been resolved.

Claims 12 and 13 have been cancelled, without prejudice. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 112, second paragraph rejections.

#### Rejections Under 35 U.S.C. § 102

In the Office Action, Claims 3-17, 20-30, and 32-36 were rejected under 35 U.S.C. § 102(e) as being anticipated by Vaughan, Jr. (U.S. Pat. No. 6,419,496).

Applicant respectfully disagrees. However, as Applicant has filed with this response a Declaration by Erwin Karl Meimer under 37 C.F.R. § 1.131 that Applicant believes removes the Vaughan reference from consideration, Applicant has not presented arguments in support of the patentability of these claims. In the Declaration, Mr. Meimer, the sole inventor, states that the invention claimed in the present application was reduced to practice prior to March 28, 2000. Applicant has included with the Declaration Exhibits A, B, C and D, which show actual reduction to practice prior to March 28, 2000. Consequently, Applicant respectfully submits that the Vaughan patent is not available as a prior art reference under 35 U.S.C. § 102(e).

Applicant respectfully submits that the rejections of Claims 3-17, 20-30, and 32-36 under 35 U.S.C. § 102(e) are thus overcome. Accordingly, Applicant requests withdrawal of the 35 U.S.C. § 102(e) rejections and allowance of Claims 3-17, 20-30, and 32-36.

Rejections Under 35 U.S.C. § 103

In the Office Action, Claims 1, 2, 18, 19 and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Vaughan, Jr. (U.S. Pat. No. 6,419,496) in view of Ho et al. (U.S. Pat. No. 6,212,358). Applicant respectfully submits that these claims are patentable over the cited references, as discussed below.

To establish a *prima facie* case of obviousness a three-prong test must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available among those of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success found in the prior art. Third, the prior art reference must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

As discussed above with regard to the 35 U.S.C. § 102 rejections, the Vaughan reference is also not available as a prior art reference under 35 U.S.C. § 103(a) due to the 37 C.F.R. § 1.131 petition. Applicant respectfully submits that a *prima facie* case of obviousness has not been established regarding Claims 1, 2, 18, 19 and 31 based solely on the Ho et al. reference. For example, the Examiner has not made the necessary showing that the Ho et al. reference alone teaches or suggests all the limitations of these claims.

In view of the foregoing, Applicant respectfully submits that the rejections of Claims 1, 2, 18, 19 and 31 under 35 U.S.C. § 103(a) are thus overcome. Accordingly, Applicant requests withdrawal of the 35 U.S.C. § 103(a) rejections and allowance of Claims 1, 2, 18, 19 and 31.

**CONCLUSION**

Applicant has endeavored to address all of the Examiner's concerns as expressed in the April 10, 2003 Office Action. Accordingly, amendments to the claims, the reasons therefore, a petition under 37 C.F.R. § 1.131, and arguments in support of the patentability of the pending claim set are presented. Any claim amendments which are not specifically discussed in the above remarks are made in order to improve the clarity of claim language, to correct grammatical

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mistakes or ambiguities, and to otherwise improve the capacity of the claims to particularly and distinctly point out the invention to those of skill in the art.

In light of the above amendments, petition and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested. If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully requested to initiate the same with the undersigned.

Respectfully submitted,

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